



22W
BAC

**MS AF
PETITION UNDER
37 C.F.R. § 1.181
EXAMINING GROUP 2653**

PATENT
0630-1150P

IN THE U.S. PATENT AND TRADEMARK OFFICE

| | | | |
|------------|---|------------|-----------|
| Applicant: | Mi Young KIM | Conf. No.: | 9860 |
| Appl. No.: | 09/662,023 | Group: | 2653 |
| Filed: | September 14, 2000 | Examiner: | A. PSITOS |
| For: | METHOD FOR CHECKING DISK LOADING STATUS IN OPTICAL DISK DRIVER | | |

PETITION UNDER 37 CFR §1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

February 15, 2005

Sir:

Applicant hereby Petitions the Commissioner to withdraw the finality of the Office Action mailed on August 27, 2004.

BACKGROUND

A first Office Action, dated March 11, 2004 contained a rejection of claims 1, 4 and 5 under 35 U.S.C. §112, Second Paragraph. The Office Action also contained rejections of claims 1-5 under 35 U.S.C. §103(a).

In an Amendment under 37 C.F.R. §1.111, filed on June 14, 2004, Applicant amended claims 1-4 in an attempt to overcome the rejection. No

attempt was made to amend the claims to overcome the prior art rejections under 35 U.S.C. §103.

The outstanding Office Action, mailed on December 23, 2004, was made final. That Office Action clearly stated that "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL.**"

In an Amendment under 37 C.F.R. §1.116, filed on November 29, 2004, Applicant requested reconsideration of the finality of the June 14, 2004 Office Action.

In that request, Applicant argued that Applicant's amendment did not necessitate the new grounds of rejection presented in the outstanding Office Action. Applicant argued that the only amendments made to claims 1, 4 and 5 were made to overcome the rejection under 35 U.S.C. §112, second paragraph.

Applicant further pointed out that, as a result of the June 14, 2004 Amendment, the terminology "multi-stage" was replaced with --multiple loading stages of the disk--, and "optical disk" was changed to --optical disk driver--, and that these changes did not affect the scope of the claims in any way. Rather, they merely made the claims clearer to understand. Applicant also stated that, because these changes did not necessitate the entirely new grounds of rejection, the outstanding Office Action was prematurely made final,

and requested that the finality of the August 27, 2004 Office Action be withdrawn.

Applicant also argued that, with the finality of the outstanding Office Action withdrawn, the Amendments are entitled to be entered per 37 C.F.R. §1.111.

An Advisory Action, dated December 23, 2004, stated that while Applicant's "amendments clarified 112 issues, the examiner could not prophesize how applicant intended to amend the claims to overcome the 112 rejections."

ARGUMENT

The changes made to claim 1 in the Amendment dated June 14, 2004 were, as follows:

a) In the claim preamble, "checking a disk in an optical disk" was changed to -- checking a disk in an optical disk driver -- to eliminate the contradiction of checking a disk in an optical disk. The contradictory language that was changed was apparently due to a non-idiomatic English language translation of Applicant's originally filed Korean language priority patent application. This type of amendment is usually appreciated by Examiners because it improves the readability of the application and removes obviously contradictory language.

b) "discriminating a loading status of an optical disk by multi-stage" was

changed to read -- discriminating a loading status of an optical disk during multiple loading stages of the disk -- to clarify the metes and bounds of the invention based on the Examiner's statement in the body of the rejection of this claim under 35 U.S.C. §112, second paragraph, that the phrase "by multi-stage" was not understood.

This amendment merely clarified what Applicant's non-idiomatic English expression "discriminating a loading status of an optical disk by multi-stage" actually meant in idiomatic English, and did not add any features to the claim that were not already there.

c) "transmitting corresponding information to a host connected through an interface in case that disk has been jammed upon discrimination" was amended to read -- transmitting information to a host connected through an interface to the optical disk driver in case that the disk has been jammed based on the discrimination --. Applicant respectfully submits that this amendment placed the non-idiomatic English claim language into idiomatic English. The portion of the amendment stating that the host is connected through an interface to the optical disk driver merely indicates what claim element the device is connected to via the interface as an operative device.

(d) In the last clause of claim 1, the indefinite article "a" was inserted in between "performing disk-ejection" so it would read -- performing a disk-ejection --. This amendment was made to make the clause grammatically correct.

None of the amendments made to claim 1 changed the claims so as to require further consideration or search by the Examiner.

Similar, clarifying amendments were made to claims 2, 3 and 4, none of which required further consideration or search by the Examiner.

Applicant respectfully submits that the claim amendments filed on June 14, 2004 did not necessitate the withdrawal of the previously applied references and application of new prior art references and different rejections of claims 1-5 for the reasons stated above.

Additionally, Applicant respectfully submits that the reason stated in the Advisory Action to deny the request to withdraw the finality of the August 20, 2004 Office Action (i.e., that the Examiner cannot prophesize what amendments Applicant is going to make) is fundamentally flawed. The Examiner knew, when the August 27, 2004 Office Action was prepared, what amendments to claims 1-5 had been made and the statement that the Examiner cannot prophesize what amendments Applicant is going to make simply does not apply to the Amendment filed on June 14, 2004.

CONCLUSION

Applicant's Amendment filed on June 14, 2004 did not necessitate the new grounds of rejection of claims 1-5 that were contained in the August 27, 2004

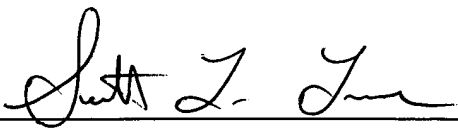
Office Action. Accordingly, the August 27, 2004 Office Action should not have been made final and must be withdrawn.

Applicant respectfully requests that the finality of the August 27, 2004 Office Action be withdrawn, the Amendment filed on November 29, 2004 be entered, and the Examiner be required to promptly act on the merits of the Amendment filed on November 29, 2004.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 

Scott L. Lowe
Reg. No.: 41,458

SLL/RJW:gf

P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703) 205-8000